

Attorney Docket No.: 001.00001

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



Applicant: Daniel FISHER
Serial No.: 09/696,956

Examiner: Charles Chow

Filed: October 27, 2000
For: Angle Rate Interferometer
And Passive Ranger

Group Art Unit: 2685

Mail Stop AF
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Responsive to the March 9, 2006 Office Action, please reconsider the application in light of the following remarks and the applicable patent law.

A. The Office Action erroneously rejects claim 1 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 3,816,834 to Wilson view of U.S. Patent No. 4,893,316 to Janc et al. The Office Action admits that Wilson fails to teach (1) a processor in low frequency oscillator 18, and (2) that the reference signal is characterized by a constant predetermined frequency. However, the Office Action asserts that FIG. 6 of Janc et al. discloses a digital frequency source 626 for replacing oscillator 18 of Wilson where the frequency is "characterized by a constant predetermined frequency" as specified in claim 1.

Even if, *arguendo*, FIG. 6 of Janc et al. depicts a direct digital synthesizer (DDS), the art applied fails to suggest a motivation to replace Wilson's low frequency oscillator 18 with Janc's DDS. The Office Action asserts that the motivation is "to generate accurate, stable, local oscillator signals" (page 3, line 7). However, the legal standard is that motivation can only be found where the evidence shows a teaching or suggestion of the desirability of the specific modification or combination. "[T]here must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant" (emphasis added), *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed Cir. 1998). "[P]articular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention would have selected these components for combination in the manner claimed," *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). Although, Janc et al. discloses "Referring now to FIG. 6, digital quadrature LO 626 is depicted in block diagram form. Implementation of a DZISS hinges on the ability to generate accurate and stable discrete time representations of sine and cosine waveforms for the quadrature mixing process" (see column 11, lines 1-5), the art applied fails to suggest a motivation to replace Wilson's low frequency oscillator 18 with Janc's DDS.

please
enter
the
amendment.
c.c.